

Applicant: Nakagawa et al.
U.S.S.N.: 09/051,670
Filed: September 8, 1998
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The application has also been amended to include a reference to prior applications. Support for this amendment is found in the Declaration submitted in this application on September 1, 1998.

Claim 6 has been amended to place the claim into independent form by reciting a method to produce a protein having a sequence comprising SEQ ID NO:3. In addition, Claim 6 has been amended to delete a misplaced “.”.

Claim 6 has also been amended to delete reference to the step of isolating the expressed protein, as suggested by the Examiner during a telephonic interview on April 19, 2000.

No new matter has been introduced by these amendments.

Remarks

Applicants thank the Examiner for the telephonic interview of April 19, 2000, during which possible Examiner Amendments were discussed.

Claims 1, 2, 5, and 6 are pending in this application. In the Office Action mailed on May 1, 2000, the Examiner withdrew the finality of the prior Office Action, stated that the specification failed to include reference to prior applications, objected to Claim 6 under 37 C.F.R. § 1.75(c) and for an informality, and rejected Claim 6 under 35 U.S.C. § 112, first paragraph. The Examiner stated that Claims 1,2 and 5 were allowable.

A. Reference to Prior Applications

The Examiner stated that the specification failed to comply with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 because it failed to include a reference to earlier applications. Applicants have amended the specification to include such a reference. Accordingly, Applicants respectfully submit that the Examiner's statement has been fully addressed.

B. The Objections

The Examiner objected to Claim 6 as being of improper dependent form for failing to further limit the subject matter of a previous claim, and for containing a misplaced “.”. Applicants have amended Claim 6 to place the claim in independent form and to delete the misplaced “.”. As such, Applicants respectfully request that the objections to Claim 6 be withdrawn.

C. The Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected Claim 6 under 35 U.S.C. § 112, first paragraph, as not being enabled in the specification. Specifically, the Examiner stated that Claim 6 recited a method of producing a protein having a sequence comprising SEQ ID NO:3 by using a DNA molecule having a sequence comprising SEQ ID NO:1 followed by SEQ ID NO:2, but that such a DNA molecule would not produce a protein corresponding to SEQ ID NO:3. Applicants have amended a typographical error at position three of SEQ ID NO:3, and submit that, as amended, a DNA molecule having a sequence comprising SEQ ID NO:1 followed by SEQ ID NO:2 would produce a protein having a sequence comprising SEQ ID NO:3.

In addition, the Examiner stated that the specification fails to teach one skilled in the art how to obtain a protein corresponding to SEQ ID NO: 3 in a mammalian host that cleaves the signal peptide. As suggested by the Examiner during the telephonic interview of April 19, 2000, Applicants have amended Claim 6 to delete reference to the step of isolating the expressed protein. Accordingly, Applicants respectfully request that the rejections of Claim 6 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

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Applicants respectfully submit that the Claim 6, as well as Claims 1, 2, and 5, are in condition for allowance. If the Examiner believes that a conversation with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at the telephone number below.

Respectfully submitted,

Date: 7/27/00
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